

### **REMARKS**

Favorable reconsideration and allowance of the present application is respectfully requested.

Claims 1-15 and 27-40 are currently pending in the present application, including independent claims 1, 10, 27, and 34. Independent claim 1, for instance, is directed to a disposable shoe liner that comprises a laminate structure shaped to approximate the contours of a wearer's foot and also configured to be placed adjacent thereto. The laminate structure comprises a first substrate containing a thermoplastic polymer and a second substrate containing a thermoplastic polymer. At least one of the substrates comprises a nonwoven web. Further, the thermoplastic polymer of the first substrate is fused together with the thermoplastic polymer of the second substrate to form fused portions and unfused portions located between the fused portions. The unfused portions define pockets containing discrete regions of a functional material that is capable of providing comfort to the wearer's foot.

In the recent Office Action, claims 27-40 were allowed. Independent claims 1 and 10, however, were rejected under 35 U.S.C. §102(b) as being anticipated by either U.S. Patent Nos. 5,938,650 to Baer, et al. or 4,892,535 to Bjornberg, et al. Baer, et al. relates to an absorbent core for absorbing liquids (e.g., component of a diaper or incontinent device), while Bjornberg, et al. relates to absorbent pads (e.g., incontinence pads). To the contrary, independent claims 1 and 10 are specifically directed to a disposable shoe liner for a shoe. The above-cited references simply do not relate in any manner whatsoever to a shoe liner for use by a wearer of a shoe.

Regardless, the Examiner previously stated that the limitation “shaped to fit the contours of a foot” does not structurally distinguish the claims from the prior art since “feet come in many different shapes and sizes.” Without commenting on the correctness of this assertion, Applicants nevertheless amended independent claims 1 and 10 in its response dated August 18, 2004 to more positively recite that that the claimed shoe liner is used by a wearer of a shoe, and is thus shaped to fit the contours of and configured to be placed adjacent to the wearer’s foot. The recent Office Action, however, states that the above-referenced limitations are merely an “intended use” and that the prior art structure is capable of performing the intended use and thus meets the claim. The Office Action also states that in “a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.”

Contrary to the assertions in the Office Action, the requirement in independent claims 1 and 10 that the laminate structure is “shaped to approximate the contours of a wearer’s foot” is *not* an intended use, but is instead a required feature of the laminate structure. That is, the laminate structure has the shape of a foot as opposed to some other shape, such as an incontinence device. This is akin to requiring that a device have a “rectangular shape.” Although rectangles come in many sizes, the “rectangular” nature of the device is certainly a structural limitation. In addition, Applicants also note that independent claims 1 and 10 are *not* drawn to a “process of making” as suggested in the Office Action, but instead to a “disposable shoe liner.”

Thus, for at least the reasons set forth above, Applicants respectfully submit that independent claims 1 and 10 are not anticipated by the cited references. In addition, the above-mentioned references were also cited to reject dependent claims 2, 4-8 and


11-13. Applicants respectfully submit, however, that at least for the reasons indicated above relating to corresponding independent claims 1 and 10, claims 2, 4-8, and 11-13 patentably define over the references cited. However, Applicants also note that the patentability of dependent claims 2, 4-8, and 11-13 does not necessarily hinge on the patentability of independent claims 1 and 10. In particular, some or all of these claims may possess features that are independently patentable, regardless of the patentability of claims 1 and 10.

As such, for at least the reasons set forth above, Applicants respectfully submit that the present claims patentably define over all of the prior art of record. It is believed that the present application is in complete condition for allowance and favorable action, therefore, is respectfully requested. Examiner Loney is invited and encouraged to telephone the undersigned, however, should any issues remain after consideration of this response.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully submitted,

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Date: 1/18/05